

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/047,817

Applicant: Brown

Filed: January 15, 2002

TC/AU: 1617

Examiner: Capps, K. J.

Docket No.: 214967

Customer No.: 23460

APPELLANT'S CORRECTED APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated October 19, 2006, Appellant now submits his Corrected Appeal Brief. The only difference between this Corrected Appeal Brief and the Appeal Brief dated March 19, 2007, pertains to the concise explanation of the subject matter of each independent claim and which refers to the specification.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to Cosmetic Laboratories of America, a division of St. Ives Laboratories, who is the real party in interest.

Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

Status of Claims

The status of the claims is set forth in the Appendix attached hereto. Claims 1, 7-9, 11-32, and 53-58 are currently pending and are the subject of this appeal.

Status of Amendments

All amendments have been entered by the Office.

Summary of Claimed Subject Matter

Appealed claims 1, 7-9, 11-28, and 53-57 are directed to a pigmented cosmetic composition comprising a water-in-oil emulsion comprising (a) from about 30% to about 40% by weight of an oil phase, (b) from about 30% to about 50% by weight of an aqueous phase, (c) from about 5% to about 15% by weight of a pigment, (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier, and (e) a separation inhibitor comprising from about 0.1% to about 7% by weight of a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein the composition is stable for at least three months at about 50 °C (see, for example, independent claims 1 and 28 and specification at page 4, lines 3-19 and page 7, line 21 - page 11, line 34). The emulsion can optionally comprise additional ingredients, such as a sunscreen agent, a thickener, an inorganic salt, a preservative, a fragrance, and/or a vitamin (see, for example, independent claim 28 and specification at page 11, line 35 - page 14, line 25).

In an embodiment of the invention, the pigmented cosmetic composition comprises a water-in-oil emulsion, said emulsion comprising (a) from about 30% to about 40% by weight of an oil phase comprising cyclomethicone, phenyl trimethicone, cyclopentasiloxane, and dimethylpolysiloxane; (b) from about 30% to about 50% by weight of an aqueous phase; (c) from about 5% to about 15% by weight of a pigment that is surface treated with a silicone; (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and (e) a separation inhibitor comprising from about 0.1% to about 7% by weight of a silicone elastomer that comprises a dimethicone cross-polymer, and wherein the composition is stable for at least three months at about 50 °C (see, for example, independent claim 58 and specification at page 7, line 21 - page 11, line 34 and Example 1).

Appealed claims 29-32 pertain to a particulate sunscreen composition comprising a water-in-oil emulsion, said emulsion comprising (a) from about 30% to about 40% by weight of an oil phase; (b) from about 30% to about 50% by weight of an aqueous phase; (c) from about 1% to about 35% by weight of a particulate sunscreensing agent; (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and (e) a separation inhibitor comprising from about 0.1% to about 7% by weight of a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein the composition is

stable for at least three months at about 50 °C (see, for example, independent claim 29 and specification at page 7, line 21 - page 11, line 34 and page 12, line 31 - page 13, line 14).

It has been found that including a silicone elastomer in the inventive water-in-oil emulsions inhibits separation of the resulting product, even over long periods of time. Thus, advantageously, the cosmetic composition of the invention is relatively stable such that it desirably does not separate, even over extended periods of time. The composition desirably is able to remain stable even upon exposure to temperature fluctuations, such that the composition is stable for at least three months at about 50 °C (see, for example, specification at page 6, line 23 - page 7, line 6). In addition, the composition can be readily applied uniformly and exhibits desirable coverage, skin feel, wear, and appearance characteristics (see, for example, specification at page 5, lines 8-21).

Grounds of Rejection to be Reviewed on Appeal

- Whether claims 1, 7-9, 11-32, and 53-58 are un-patentable under 35 U.S.C. § 103(a) in view of U.S. Patent 5,599,533 (Stepniewski et al.) in combination with U.S. Patents 5,730,991 (Rapaport) and 5,882,661 (Dorogi et al.).
- Whether claims 1, 7-9, 11-32, and 53-58 are un-patentable under 35 U.S.C. § 103(a) in view of Stepniewski et al., Rapaport, and Dorogi et al., further in view of U.S. Patent 5,656,672 (Collin et al.)

Argument

A. Rejection of Claims 1, 7-9, 11-32, and 53-58 under Section 103(a) in view of Stepniewski et al. in combination with Rapaport and Dorogi et al.

Stepniewski et al. allegedly discloses cosmetic compositions comprising water-in-oil emulsions comprising an oil phase, a water phase, a pigment, a sunscreensing agent including a preservative, an emulsifier or surfactants with an HLB value of 2-6 in 0.01-20 wt% or cetyl dimethicone copolyol in 0.5 wt%, a thickener, a separation inhibitor, a silicone elastomer, and an inorganic salt. The Office concedes that Stepniewski et al. does not expressly disclose the use of a cetyl dimethicone copolyol in about 3-6 wt%.

Rapaport discloses a skin peel composition that can include octyl methoxycinnamate as a sunscreen agent.

Dorogi et al. discloses a composition for treating or conditioning human skin, hair, or nails. The composition can include phenoxyethanol, propyl paraben, and methyl paraben as preservatives.

According to the Office, it would have been obvious to combine the elements disclosed by Rapaport and Dorogi et al. with the compositions taught by Stepniewski et al. in order to arrive at the instant invention. Specifically, the Office contends that since Stepniewski et al. describes using a surfactant in 0.01-20 wt% and also describes using a cetyl dimethicone copolyol, it would have been obvious to optimize this parameter to arrive at the feature of 3-6 wt%.

In order to establish a *prima facie* case of obviousness with respect to a claim, at least two criteria must be met: (1) the prior art references must suggest to one of ordinary skill in the art to make the subject matter defined by the claims in issue and (2) the prior art references must provide one of ordinary skill in the art with a reasonable expectation of success in so making the subject matter defined by the claims in issue. Both the suggestion and the reasonable expectation of success must be found in the prior art references, not in the disclosure of the patent application in issue. See, e.g., *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

As stated in the Office Action, Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%. Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%. It is conceded by the Office that Stepniewski et al. does not disclose the use of about 3-6 wt% of a cetyl dimethicone copolyol. Accordingly, the disclosure of Stepniewski et al. must be modified to arrive at the invention defined by the appealed claims. The suggestion or motivation to modify the disclosure of a reference must be in the cited reference or in the knowledge generally available to one of ordinary skill in the art. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Yet there is nothing in Stepniewski et al. that would have suggested to one of ordinary skill in the art to utilize about 3-6 wt% of a cetyl dimethicone copolyol, and the Examiner does not cite to any teaching in Stepniewski et al. that would motivate a person of ordinary skill in the art to use exactly the claimed amount of a cetyl dimethicone copolyol and provide a composition is stable for at least three months at about 50 °C so as to arrive at the present invention.

Even if, for the sake of argument, the present invention is considered to be *prima facie* obvious in view of Stepniewski et al., the existence of unexpected properties and improved characteristics, relative to cosmetic compositions of the prior art, serve to rebut the *prima facie* obviousness and support the patentability of the present invention as defined by the appealed claims. Applicant has unexpectedly discovered that adding about 3-6 wt% of a cetyl dimethicone copolyol emulsifier to the water-in-oil emulsion lends unusual stability to the present invention. Applicant previously submitted a fourth Rule 132 Declaration that summarizes the results of the three prior Rule 132 Declarations and describes the amounts of all the ingredients in each formulation. As seen in the fourth Rule 132 Declaration, compositions of the present invention comprising about 3-6 wt% cetyl dimethicone copolyol were stable for at least three months at 50 °C (see, for example, Example 1 and Samples C-G).

In contrast, compositions comprising a cetyl dimethicone copolyol emulsifier in an amount *outside* of the claimed range were *not* similarly stable. Specifically, Comparative Samples A and B comprising about 1 wt% and about 8 wt% cetyl dimethicone copolyol, respectively, were not similarly stable. The composition containing about 8 wt% cetyl dimethicone copolyol did not provide an emulsion that was stable for at least three months at 50 °C. For example, Comparative Sample B with about 8% cetyl dimethicone copolyol separated into individual layers within a matter of days. Similarly, Comparative Sample A, which contained about 1 wt% cetyl dimethicone copolyol, provided an emulsion that was initially stable but fell apart after about one and a half months.

Thus, compositions comprising amounts of cetyl dimethicone copolyol *outside* of the claimed range of about 3-6 wt% are *not* stable for three month at 50 °C. Thus, even though Stepniewski et al. describes using a surfactant in the broad range of about 0.01-20 wt%, Applicant has shown that values *outside* of the claimed range (i.e., about 1 wt% and about 8 wt% cetyl dimethicone copolyol) but falling *within* the broad range of 0.01-20 wt%, do not provide a stable emulsion. Therefore, it cannot be said that Stepniewski et al. renders the present invention obvious, since Stepniewski et al. clearly does not recognize any benefit in providing a composition specifically comprising about 3-6 wt% of a cetyl dimethicone copolyol. Without any suggestion of improved stability, one of ordinary skill in the art would not have had any reasonable expectation of success that a composition comprising 3-6 wt% would have any surprising or unexpected properties. It is arguable that based on Stepniewski

et al.'s disclosure, the ordinarily skilled artisan would be equally led to provide pigmented compositions comprising 1 wt% or 8 wt% cetyl dimethicone copolyol. However, as discussed above, compositions comprising cetyl dimethicone copolyol *outside* of the claimed range are not stable for 3 months at 50 °C. The Examiner's position with respect to Stepniewski et al. appears to be premised on hindsight knowledge of the present invention – an approach which is not proper. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985) ("It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a 'blueprint.'").

Under the circumstances, and contrary to the Examiner's position, the disclosure of Stepniewski et al., Rapaport, and Dorogi et al., cannot be considered to properly render obvious the subject matter of the appealed claims.

B. Rejection of Claims 1, 7-9, 11-32, and 53-58 under Section 103(a) in view of Stepniewski et al. in combination with Rapaport, Dorogi et al., and Collin et al.

As described above, Stepniewski et al. allegedly discloses cosmetic compositions comprising water-in-oil emulsions comprising an oil phase, an aqueous phase, a pigment, a cetyl dimethicone copolyol, and a silicone elastomer. Stepniewski et al. does not, however disclose that cetyl dimethicone copolyol should be used in about 3-6 wt%, as required by the pending claims, and which amount leads to surprising and unexpected stability of the inventive compositions. According to the Office, Rapaport and Dorogi et al. disclose compositions comprising octylmethoxycinnamate as a preferred sunscreen component, and phenoxyethanol, methyl paraben, and propyl paraben as preferred preservatives, respectively. It is conceded that Rapaport and Dorogi et al. do not provide motivation for the addition of cetyl dimethicone copolyol in an amount of about 3-6 wt%.

The appealed claims are not obvious because one having ordinary skill in the art would not have been motivated to somehow combine the various disparate teachings of the cited references, selectively pick and choose components of the compositions disclosed therein, and somehow arrive at the presently claimed composition. Collin et al. relates to maintaining stability and activity of retinol acne formulations with an organic solvent. Cetyl dimethicone copolyol is added as an emulsifier to the water-in-oil emulsion, yet Collin et al. does not associate any superior or surprising results associated with the use of cetyl

dimethicone copolyol. It cannot be said that Collin et al. knowingly provides one of ordinary skill in the art the knowledge to prepare a composition that is stable for at least three months at about 50 °C by adding 3-6 wt% of a cetyl dimethicone copolyol. In contrast, Collin et al. reports that it is the organic solvent—and not the cetyl dimethicone copolyol—that stabilizes the retinol (col. 7, lines 33-40). Without recognizing the unforeseen benefit of using 3-6 wt% of a cetyl dimethicone copolyol in the claimed composition and since the use of emulsifiers is so common, the ordinarily skilled artisan would not be led to the specific disclosure of Collin et al. and, in particular, its use of cetyl dimethicone copolyol.

As discussed above, Stepniewski et al. generally discloses compositions comprising a very broad range of 0.01-20 wt% of a long list of suitable surfactants (col. 4, lines 19-35). Stepniewski et al. does not recognize any perceived benefits of using cetyl dimethicone copolyol in 3-6 wt%. After reading Stepniewski et al., one of ordinary skill in the art would not appreciate that 3-6 wt% cetyl dimethicone copolyol, as opposed to any other of the numerous surfactants disclosed therein, lends any surprising stability to the emulsion. As a result, the ordinarily skilled artisan would not be pointed to the disclosure of Collin et al. since it pertains to maintaining retinol activity and not emulsion stability. There simply is no connector between the cited references that would lead one of ordinary skill in the art to provide the claimed composition. The rejection is thus unsupported factually and legally. “The motivation to combine references can not come from the invention itself.”

Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 U.S.P.Q.2d 1377 (Fed. Cir. 1993).

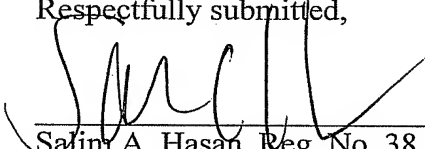
Moreover, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability, this amounts to nothing more than impermissible hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617. (Fed. Cir. 1999). Absent the teachings of the present application and the impermissible use of hindsight, in view of all of the literature available at the time of filing the present application, one of ordinary skill in the art would not be led to the disclosure of Collin et al.

Without motivation to combine references, the Office has not met its burden to establish a *prima facie* case of obviousness. Accordingly, the obviousness rejection is improper and should be reversed.

Conclusion

For the foregoing reasons, Appellants respectfully request the reversal of the rejection of the subject patent application.

Respectfully submitted,



Salim A. Hasan, Reg. No. 38,175
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
180 North Stetson Ave., Suite 4900
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: March 22, 2007

Claims Appendix

1. (Previously presented) A pigmented cosmetic composition comprising a water-in-oil emulsion, said emulsion comprising:

- (a) from about 30% to about 40% by weight of an oil phase;
- (b) from about 30% to about 50% by weight of an aqueous phase;
- (c) from about 5% to about 15% by weight of a pigment;
- (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and

(e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein said silicone elastomer is present in an amount of from about 0.1% to about 7% by weight of said composition, wherein the composition is stable for at least three months at about 50 °C.

2.-6. (Canceled)

7. (Original) The composition of claim 1, wherein the aqueous phase comprises an alcohol.

8. (Original) The composition of claim 1, wherein the aqueous phase comprises a glycol.

9. (Original) The composition of claim 1, wherein the oil phase comprises a silicone oil.

10. (Canceled)

11. (Previously presented) The composition of claim 1, wherein the separation inhibitor further comprises a carrier for the dimethicone cross-polymer.

12. (Original) The composition of claim 11, wherein the carrier is cyclomethicone.

13. (Original) The composition of claim 1, wherein the pigment is selected from the group consisting of titanium dioxide, yellow iron oxide, red iron oxide, black iron oxide,

zinc oxide, talc, mica, magnesium carbonate, calcium carbonate, magnesium silicate, aluminum magnesium silicate, silica, ultramarine, nylon powder, polyethylene powder, polystyrene powder, silk powder, crystalline cellulose, starch, titanated mica, iron oxide titanated mica, bismuth oxychloride, and combinations thereof.

14. (Original) The composition of claim 13, wherein the pigment is surface treated.

15. (Original) The composition of claim 14, wherein the pigment is surface treated with silicone.

16. (Original) The composition of claim 1, wherein the emulsion further comprises a sunscreensing agent.

17. (Original) The composition of claim 16, wherein the sunscreensing agent is present in an amount of from about 5% to about 15% by weight of said composition.

18. (Original) The composition of claim 1, wherein the emulsion further comprises a thickener.

19. (Original) The composition of claim 18, wherein the thickener is present in an amount of from about 0% to about 10% by weight of said composition.

20. (Original) The composition of claim 1, wherein the emulsion further comprises an inorganic salt for enhancing the formation of the water-in-oil emulsion.

21. (Original) The composition of claim 20, wherein the inorganic salt is present in an amount of from about 0% to about 4% by weight of said composition.

22. (Original) The composition of claim 20, wherein the inorganic salt is selected from the group consisting of sodium chloride, magnesium chloride, magnesium sulfate, and combinations thereof.

23. (Original) The composition of claim 1, wherein the emulsion further comprises a preservative.

24. (Original) The composition of claim 23, wherein the preservative is present in an amount of from about 0% to about 2% by weight of said composition.

25. (Original) The composition of claim 1, wherein the composition is a make-up.

26. (Original) The composition of claim 25, wherein the make-up is selected from the group consisting of a foundation, a rouge, a concealer, eye-shadow, eye-liner, a mascara, a lipstick, and a lipcolor.

27. (Original) The composition of claim 1, wherein the composition is a sunscreen.

28. (Previously presented) A pigmented cosmetic composition comprising a water-in-oil emulsion, said emulsion comprising:

- (a) from about 30% to about 40% by weight of an oil phase;
- (b) from about 30% to about 50% by weight of an aqueous phase;
- (c) from about 5% to about 15% by weight of a pigment;
- (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and
- (e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein said silicone elastomer is present in an amount of from about 0.1% to about 7% by weight of said composition; and optionally, one or more of the following ingredients:
 - (i) a sunscreensing agent;
 - (ii) a thickener;
 - (iii) an inorganic salt;
 - (iv) a preservative;
 - (v) a fragrance; and
 - (vi) a vitamin,

wherein the composition is stable for at least three months at about 50 °C.

29. (Previously presented) A particulate sunscreen composition comprising a water-in-oil emulsion, said emulsion comprising:

- (a) from about 30% to about 40% by weight of an oil phase;
- (b) from about 30% to about 50% by weight of an aqueous phase;
- (c) from about 1% to about 35% by weight of a particulate sunscreensing agent;
- (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and
- (e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein said silicone elastomer is present in an amount of from about 0.1% to about 7% by weight of said composition, wherein the composition is stable for at least three months at about 50 °C.

30. (Original) The composition of claim 29, wherein the particulate sunscreensing agent is a metal oxide or combinations thereof.

31. (Original) The composition of claim 30, wherein the particulate sunscreensing agent is selected from the group consisting of zinc oxide, titanium dioxide, and combinations thereof.

32. (Original) The composition of claim 29, wherein said emulsion further comprises at least one of the following optional ingredients:

- (i) a pigment;
- (ii) a thickener;
- (iii) a preservative;
- (iv) an inorganic salt;
- (v) a fragrance; and
- (vi) a vitamin.

33-52. (Canceled)

53. (Previously presented) The composition of claim 9, wherein the oil phase comprises cyclomethicone, phenyl trimethicone, cyclopentasiloxane, and dimethylpolysiloxane.

54. (Previously presented) The composition of claim 15, wherein the silicone is dimethicone.

55. (Previously presented) The composition of claim 16, wherein the sunscreens agent is at least one compound selected from the group consisting of octyl methoxycinnamate and octyl salicylate.

56. (Previously presented) The composition of claim 18, wherein the thickener is at least one compound selected from the group consisting of quarternium-19 hectorite and propylene carbonate.

57. (Previously presented) The composition of claim 23, wherein the preservative is at least one compound selected from the group consisting of phenoxyethanol, methylparaben, propylparaben, and disodium ethylenediaminetetraacetate (EDTA).

58. (Previously presented) A pigmented cosmetic composition comprising a water-in-oil emulsion, said emulsion comprising:

- (a) from about 30% to about 40% by weight of an oil phase comprising cyclomethicone, phenyl trimethicone, cyclopentasiloxane, and dimethylpolysiloxane;
- (b) from about 30% to about 50% by weight of an aqueous phase;
- (c) from about 5% to about 15% by weight of a pigment that is surface treated with a silicone;
- (d) from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier; and
- (e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, and wherein said silicone elastomer is present in an amount of from about 0.1% to about 7% by weight of said composition, wherein the composition is stable for at least three months at about 50 °C.

Evidence Appendix

Not applicable.

Related Proceedings Appendix

Not applicable.